

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/646,855

Applicant(s)

OHMI ET AL.

Examiner

John J. Zimmerman

Art Unit

1794

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 19 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/John J. Zimmerman/  
Primary Examiner, Art Unit 1794

Continuation of 3. NOTE: The proposed amendments will not be entered since they raise the issue of new issues and new matter. Specifically, applicant proposes to require a film consisting of Cr<sub>2</sub>O<sub>3</sub> at a depth of approximately 30 nm from the outermost surface (e.g. see proposed claim 3, lines 13-15). This proposed amendment is a new issue that would require further consideration and/or search since it was not previously presented in this prosecution. The introduction of new issues is not timely at this point in prosecution. In addition, chromium forms various oxides (e.g. CrO, Cr<sub>2</sub>O<sub>3</sub>, CrO<sub>2</sub>, CrO<sub>3</sub>) and therefore there is no evidence of record that a ratio of 60:40 (O:Cr) must necessarily be 100% Cr<sub>2</sub>O<sub>3</sub> ("consisting of") at approximately 30 nm from the outermost surface .

Continuation of 11. does NOT place the application in condition for allowance because: The request for reconsideration has been carefully considered, but in view of the non-entry of the proposed amendment, applicant's arguments addressing the proposed amendment are not commensurate with the current claim limitations. As noted in section 3, above, applicant has not yet resolved the new matter issue since chromium forms various oxides (e.g. CrO, Cr<sub>2</sub>O<sub>3</sub>, CrO<sub>2</sub>, CrO<sub>3</sub>) and therefore there is no evidence of record that a ratio of 60:40 (O:Cr) must necessarily be 100% Cr<sub>2</sub>O<sub>3</sub> ("consisting of") at approximately 30 nm from the outermost surface. The element concentrations for chromium and oxygen at approximately 30 nm from the outer surface could result from a mixture of different chromium oxides. In addition, since the disclosure (e.g. page 9, lines 8-10) only suggests "substantially 100%" chromium oxide at approximately 30 nm from the surface, this disclosure would allow for mixtures of chromium oxide and also non-chromium oxide constituents (e.g. chromium metal) and therefore would not necessarily provide support for "consisting of" Cr<sub>2</sub>O<sub>3</sub>. In addition, a review of Figure 2 at 30 nm does not clearly establish that the ratio is specifically 60:40 (O:Cr) at that depth. Figure 2 appears to show less than 60% oxygen and more than 40% chromium at a depth of 30 nm from the outer surface. Since applicant has not yet proven support for the claimed subject matter, and since the proposed amendment has not been entered, the new matter rejection has been maintained.